

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAO A. CHEN and NATHAN W. EASTERDAY

Appeal 2007-1262
Application 10/697,532
Technology Center 1772

Decided: June 13, 2007

Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and
CHUNG K. PAK, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

DECISION ON APPEAL

We AFFIRM.

This is a decision on an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-39. We have jurisdiction under 35 U.S.C. § 6.

The Appellants invented a surface covering panel and a method of making such a panel. The panel comprises a support layer 1, a base coating 2 having a textured surface 3 on top of the support layer, a printed pattern 4

Appeal 2007-1262
Application 10/697,532

on and registered with the textured surface, and a protective layer 5 on the printed pattern (figure 1). The aforementioned panel and method are respectively described in claims 1 and 18 as follows:

1. A surface covering panel comprising:

at least one support layer with or without texturing; at least one base coating located on top of said support layer having a textured surface; at least one printed pattern located on said textured surface and in registered with said textured surface; and at least one protective layer located on the printed pattern.

18. A method of making the surface covering panel of claim 1, wherein said method comprises applying at least one base coating onto a support surface;

applying a textured surface onto said base coating to form a textured surface; printing a pattern onto said textured surface; applying at least one protective coating onto said printed pattern; wherein said textured surface and said printed pattern are in register.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

Hansson	US 6,465,046 B1	Oct. 15, 2002
Casto	US 1,947,459	Feb. 20, 1934

Appeal 2007-1262
Application 10/697,532

The claims of the following patents are relied upon by the Examiner in the obviousness-type double patenting rejections on appeal:¹

Chen (Chen '009)	US 6,617,009 B1	Sep. 9, 2003
Chen (Chen '934)	US 6,986,934 B2	Jan. 17, 2006
Chen (Chen '460)	US 7,169,460 B1	Jan. 30, 2007

Claims 1-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hansson in view of Casto.

Claims 1-39 also are rejected under the judicially created doctrine of obviousness-type double patenting over (1) the claims of Chen '009; (2) the claims of Chen '460; and (3) the claims of Chen '934.

OPINION

We will sustain each of these rejections for the reasons expressed in the Answer and below.

The § 103 Rejection

As background to their invention, the Appellants describe the conventional approach to forming a surface covering panel such as laminate flooring which involves a method known in the art as embossed-in-register wherein first a printed pattern is formed on a substrate and then a textured design is embossed on and in registry with the printed pattern (Br. 7-8; Specification 1-3). In contrast, the Appellants characterize their invention as

¹ The Answer includes double patenting rejections based on the claims of Application No. 09/630,121 and Application No. 10/909,684. These respective applications have now matured into U.S. Patent No. 7,169,460 B1 and U.S. Patent No. 6,986,934 B2. In this decision, we refer to these patent numbers rather than the application numbers.

Appeal 2007-1262
Application 10/697,532

printed-in-register wherein first a textured design is embossed on a substrate and then a printed pattern is placed on and in registry with the so-formed textured surface (Br. 8-9; Specification 4-5). Concerning the prior art rejection based on Hansson, the Appellants state that Hansson teaches forming an embossed-in-register product rather than the here-claimed printed-in-register product (Br., para. bridging 19-20 and 20-21).

As an initial matter, the claim 1 product which is made by a printed-in-register method appears to be indistinguishable from the above-discussed prior art product which is made by an embossed-in-register method. For example, in both products, a printed pattern is located on and in registry with a textured surface. Although the textured surface of the prior art product is formed by embossing the printed pattern and its underlying substrate (Specification 2-3), the result is a printed pattern on top of a textured surface as required by claim 1. Regarding this point, we emphasize that patentability of a product claim is not based on the process by which it is made. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1583, 18 USPQ2d 1001, 1016 (Fed. Cir. 1991).

Regardless, Appellants' method claim 18 unquestionably requires the sequential steps of first texturing a base coating surface and then printing a pattern onto the textured surface in registry therewith. According to the Examiner, it would have been obvious for an artisan to provide the method of Hansson with this step sequence in view of Casto, thereby obtaining the

Appeal 2007-1262
Application 10/697,532

method defined by claim 18 as well as the product defined by claim 1. We agree.

In this regard, Casto discloses a method of forming a surface covering panel product, such as wall board, having the appearance of building material, such as grained wood, marble, and tile (Casto 1, ll. 1-9). This product is made by first texturizing the product surface and then applying pigment to the textured surface (Casto 1, ll. 89-106). Upon removal of surplus pigment, the textured interstices of the surface contain pigment whereas the non-textured, outermost portions of the surface do not (Casto 2, ll. 27-36). More than one pigment color may be used in this process in order to obtain the desired appearance (para. bridging pgs. 2-3).

Casto's disclosure of first texturizing a surface and then applying pigment to the textured surface would have suggested providing Hansson with this sequence of steps because the results of this modification would have been predictable. *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). That is, an artisan would have reasonably expected that Hansson's desired product would result from this step sequence in view of Casto's teaching that the sequence yields this type of product.

The Appellants argue that no proper reasoning or justification exists for concluding that it would have been obvious to combine the applied references to thereby yield the here-claimed method and product made thereby (Br. 21). However, an obviousness conclusion is supported by the

Appeal 2007-1262
Application 10/697,532

above-noted reasoning, namely, an artisan would have reasonably expected that Hansson's desired product would predictably result from the texture then print technique of Casto. In this regard, it is appropriate to emphasize that a teaching, suggestion, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, suggestion, or motivation may be implicit from the prior art as a whole. *In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336; cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

The Appellants further argue that an obviousness conclusion is improper because Casto fills in his textured interstices, thereby "creating a smooth surface, [such that] there is no embossed surface remaining" (Br. 22). The Appellants' interpretation of the Casto disclosure is factually erroneous. Casto explicitly teaches forming a non-smooth surface to thereby reproduce tile effects where the mortar joints are represented by depressed fillings (Casto 3, ll. 34-41).

The Appellants also argue that Hansson's technique would not yield the claim 4 product wherein the printed pattern and textured design is in register to about 1 mm or less because Hansson discloses a matching tolerance of up to \pm 5 mm at column 1, lines 25-28 (Br. 27). We are unpersuaded by this argument for a number of reasons. First, a matching tolerance of \pm 5 mm would yield products with tolerances throughout this range including a product having a 1 mm or less registry as defined by

Appeal 2007-1262
Application 10/697,532

claim 4. Second, the matching tolerance range disclosed by Hansson in column 1 relates to traditional prior art techniques over which Hansson's digitally controlled technique is an improvement. Indeed, Hansson teaches that the digital data of his technique yields a surface structure (i.e., texture) that matches décor segments (i.e., printed patterns) (para. bridging cols. 9-10). Such a match would correspond to a registry of about 1 mm or less as required by claim 4.

Additionally, the Appellants make unembellished assertions that the prior art would not have suggested the particular features of certain dependent claims (Br. 27-30). We perceive no convincing merit in these unembellished assertions.

For example, both Hansson and Casto evince that embossment depth is an art-recognized, result-effective variable, thereby evincing obviousness for the embossment depth features of claims 5 and 6. *In re Woodruff*, 919 F.2d 1575, 1578 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Multiple textured surfaces as required by claim 16 would have been suggested by the multiple texturing or engraving teachings of Casto (sentence bridging pgs. 2-3; pg. 3, ll. 34-41). The claim 31 feature of an adhesive base coat between the base coating and support layer is satisfied by Hansson's first of multiple topcoat layers (examples 1-4) since this first topcoat layer would necessarily adhere to the underlying support layer and the overlying topcoat layer(s). The Appellants' nonobviousness assertion for the bottom balance layer of claim 38 is directly contradicted by Appellants' disclosure that their

Appeal 2007-1262
Application 10/697,532

invention can use “[a]ny conventional bottom balance layer” (Specification 8, l. 7; emphasis added).

For the reasons set forth above and in the Answer, the record before us evinces a *prima facie* case of obviousness for the argued claims on appeal which has not been successfully rebutted by the Appellants. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We hereby sustain, therefore, the § 103 rejection of claims 1-39 as being unpatentable over Hansson in view of Casto.

The Obviousness-Type Double Patenting Rejections

It is undisputed that each of Chen ‘009, Chen ‘460, and Chen ‘934 claims a thermoplastic plank comprising a core, a printed layer or design, and a protective layer or coating, wherein an underlay layer may be located between the print layer and core. As fully explained above and in the Answer, the combined teachings of Hansson and Casto would have suggested the Appellants’ claimed method for making products of the type defined by appealed claim 1. Analogously, these prior art references would have suggested using such a method in order to make products of the type defined by the claims of the aforementioned Chen patents. Accordingly, it would have been obvious for an artisan to manufacture the products claimed in these Chen patents with the method resulting from the previously discussed combination of Hansson and Casto, thereby resulting in the product and method defined by the appealed claims.

Appeal 2007-1262
Application 10/697,532

The Appellants argue that the Chen patent claims are all directed to a product, rather than a method, and that this claimed product is not defined as comprising a surface which is first textured and then printed with a printed pattern in registration with the textured surface (Br. 32-39). While this is true, these method and product features would have been suggested by Hansson and Casto. The Appellants' contrary view regarding this last-mentioned point is not well taken for reasons fully explained above.

Under these circumstances, we also hereby sustain the obviousness-type double patenting rejections of all appealed claims over the claims of Chen '009, Chen '460, and Chen '934 in view of Hansson and further in view of Casto.

CONCLUSION

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

clj

Kilyk & Bowersox, P.L.L.C.
400 Holiday Court
Suite 102
Warrenton, VA 20186